

REMARKS

1 The Examiner objected to claim 1 to the extent that there is no antecedent basis
for the limitation "said brace", in line 11. Applicant has amended claim 1 to refer to "the
5 bracket", rather than "said brace", and now believes the claim to be in condition for
allowance.

5 The Examiner rejected claims 1-5, 8-12, 15, 17 and 18 under 35 U.S.C. § 112(2)
as being indefinite due to the use of the approximation words "substantially" and
"generally". Applicant has amended claims 1-5, 8, 10-12, 15 and 17 to remove the
these words. The amendment is strictly for the purposes of making the claims definite
10 and not for purposes of patentability or to overcome prior art. However, in claims 9 and
18, the limitations "generally U-shaped cross-section" were left unchanged as the
limitations are proper and do not render the claims indefinite. The specification, at page
9, lines 17-21, and page 10, lines 1-3, states:

15 However, variations to this U shape are contemplated. For example, the
forward wall 12 and rearward wall 14 may be angled inwardly or outwardly
somewhat. Moreover, the size and length of the top wall 16 may be varied
to provide a larger or smaller surface upon which the new building panel
32 will rest. Accordingly, a V shape, C shape and other geometries are
contemplated. However, it is preferred that the forward wall 12 and
rearward wall 14 be of generally equal length and in a spaced-apart
relationship so that a forward and rearward footing is provided for stability.

20 Accordingly, the specification provides sufficient guidelines for a person of skill in the art
to determine the metes and bounds of the claimed invention. Ex parte Oetiker, 29
U.S.P.Q.2d 1651, 1655 (BPAI 1992). As the Examiner stated, "generally U-Shaped"
could resemble a "U" or a "C". It may also resemble a "V". However, the Examiner's
comment that it could resemble an "L" is not supported by the specification.

1 Accordingly, claims 1-5, 8-12, 15, 17 and 18 are believed to be in condition for allowance.

5 The Examiner objects to claims 1-5, 8 and 9 because they are presented as a sub-combination to the bracket, as opposed to the combination of the bracket and the other structures referred to in the preamble of claim 1. While the applicant believes the claims to be properly drafted, and advised previously that the applicant was claiming only the sub-combination set forth in the claims, applicant has amended claim 1 to read as a combination claim, which separately claims each of the structural members. Accordingly, claims 1-5, 8 and 9 are believed to be in condition for allowance.

10 The Examiner advised that claims 5, 15 and 16 would be allowable if amended to include the limitations of any independent and intervening claims. Applicant has amended claim 5 to include each of the limitations within claim 1, as amended herein to read as a combination claim. Similarly, applicant has amended claim 15 to include each of the limitations from independent claim 10. Applicant has also amended claim 16 to include each of the limitations found within independent claim 10. Accordingly, claims 5, 15 and 16 are each believed to be in condition for allowance.

20 The Examiner rejected claims 1-4, 8 and 9 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,845,446 to Funaki et al. The applicant respectfully disagrees with the aforementioned rejections. However, in an effort to expedite the prosecution of the present application, applicant has amended claim 1 to more clearly describe the present invention. Specifically, the applicant has amended claim 1 with the limitation that, "the length of said bracket is perpendicular to, lengths of the elongated

alternating peaks and valleys of the existing building panel". At page 3 of the Office
1 Action, the Examiner argues incorrectly that the bracket in Funaki is positioned
generally perpendicular to the alternating peaks and valleys of the building panel. To be
sure, the bracket and the alternating peaks and valleys in the Funaki disclosure are
5 elongated. The lengths of all the structures are positioned to be parallel with one
another, not perpendicular. The Funaki, et al. reference does not teach or otherwise
contemplate a system having the claimed structural configuration. Accordingly, claim 1
is believed to be patentable.

Claims 2-5, 8 and 9 each ultimately depend from claim 1 and are believed to be
10 allowable for at least the reasons set forth herein with respect to claim 1. Moreover,
Funaki, et al. does not teach that the bracket is comprised of a substantially insulative
material. Rather, the reference teaches that the bracket may be formed from aluminum
or extruded resin; neither of which are noted as being insulative. To be sure, aluminum
15 is conductive.

Claim 8 states that, "the lower end portions of said forward and rearward wall
portions are shaped so that a substantial portion of the lower end portions of said
forward and rearward wall portions engage the outwardly facing surface of the at least
one existing building panel." Again, this is a specific structural configuration not found
20 within the prior art bracketry and provides dramatically increased stability due to this
unique configuration.

The Examiner claims 10-13 under 35 U.S.C. § 103(a) as being obvious over the
Funaki et al. patent in further view of U.S. Patent No. 5,511,354 to Eidson. Again, the
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1 Examiner states that the Funaki et al. patent discloses each of the structural limitations
found within these claims, except for discrete structural details that are argued to be
taught or otherwise suggested within the Eidson patent. Applicant respectfully
disagrees. First, Funaki et al. teach a bracket that cannot be used for repaneling or
reroofing a structure. A person of ordinary skill in the art looking to create a new
5 bracket for such a use, that provides increased stability and usability would not, on any
objective basis look to the teachings of Funaki, et al. Moreover, the applicant has
amended claims 10 to more clearly claim the structural orientation of the bracket's
length extending perpendicular to the lengths of the elongated peaks and valleys of the
10 roof panel, rendering the teachings of Funaki, et al. inapplicable to the present method
claims.

The mere fact that the references can be modified does not render the resulting
modified structure obvious unless the prior art also suggests the desirability of the
15 combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). "A
statement that modifications of the prior art meet the claimed invention and would have
been 'well within the ordinary skill in the art at the time the claimed invention was made
because the references relied upon teach that all aspects of the claimed invention were
individually known in the art' is not sufficient to establish a *prima facie* case of
20 obviousness without some objective reason to combine the teachings of the
references." Ex parte Leavengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).
The combined teachings of the cited references do not provide a sufficient body of

1 material to render claim 10 obvious to a person of ordinary skill in the art, even in view
of the presumed knowledge held by such a person of skill in the art.

5 In determining the difference between the prior art and the claims, the question
under 35 U.S.C. § 103 is not whether the differences themselves would have been
obvious, but whether the claimed invention as a whole would have been obvious.
Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). A
prior art reference and the claimed invention must be considered in their entireties.
Distilling an invention down the "gist" or "thrust" of an invention disregards the
requirement of analyzing the subject matter "as a whole." W.L. Gore & Associates, Inc.
10 v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *Cert. denied*, 469 U.S.
851 (1984). Claim 10 is patentably distinct in view of the prior art. Claims 11, 12 and
14-18 each ultimately depend from claim 10 and are believed to be allowable for at least
the reasons set forth herein with respect to claim 10. Moreover, each of these
15 dependent claims are comprised of structural and procedural limitations similar to those
discussed with respect to claims 1-5, 8 and 9, and are believed to also be patentably
distinct in view of these structural and procedural limitations.

20 In light of the above amendments and remarks, applicant asserts that each of the
currently pending claims is believed to be patentable over the cited prior art.
Accordingly, applicant respectfully requests reconsideration and allowance of the same.

25 No fees or extensions of time are believed to be due in connection with this
amendment; however, please consider this a request for any extension inadvertently
omitted, and charge any additional fees to Deposit Account No. 502093.

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Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that the original of this AMENDMENT for ARNOLD G. LEGBAND, Serial No. 10/667,000, was mailed by first class mail, postage prepaid, to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 14th day of February, 2006.

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